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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/693,789	07/31/96	GRUBBS	CTCH-1620

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EXAMINER

NAZARIO GONZALEZ, P

ART UNIT

PAPER NUMBER

1204

DATE MAILED: 10/21/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/693,789

Applicant(s)
Grubbs et al.

Examiner
Porfirio Nazario-Gonzalez

Group Art Unit
1204



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-42 is/are pending in the application.

Of the above, claim(s) 25-36 and 39-42 is/are withdrawn from consideration.

☒ Claim(s) 37 and 38 is/are allowed.

☒ Claim(s) 1-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-42 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 and 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, 37 and 38, drawn to a carbene complex and process of making, classified in class 556, subclass 21 and elsewhere.
 - II. Claims 25-29, 40 and 41, drawn to a vinylidene complex and processes of making, classified in class 556, subclass 21 and elsewhere.
 - III. Claim 30, drawn to a polymerization process of cyclic olefins, classified in class 526, subclass 171.
 - IV. Claim 31, drawn to depolymerization process of an unsaturated polymer, classified in class 585, subclass 241.
 - V. Claim 32, drawn to the synthesis of a cyclic olefin, classified in class 585, subclass 500+.
 - VI. Claim 33, drawn to a polymerization process of a diene, classified in class 526, subclass 335+.
 - VII. Claim 34, drawn to a metathesis polymerization process, classified in class 526, subclass 171+.
 - VIII. Claims 35 and 36, drawn to a metathesis process of olefins, classified in class 585, subclass 500+.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to independent and patentably distinct compounds, for example, invention I is a metal carbene whereas invention II is a vinylidene complex.

3. Inventions I and III-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process as claimed can be practiced with another materially different product such as the catalysts disclosed on Pat. No. 5,296,566 or other Group VIII metal carbene complexes.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. W. Patrick Bengtsson on October 10, 1997 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-24, 37 and 38. Affirmation of this election must be made by applicant in responding to this Office action. Claims 25-36 and 39-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Priority

7. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Drawings

8. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Double Patenting

9. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ

10. Claims 1-24 are rejected under the judicially created doctrine of double patenting over claims 1 and 4-6 of U. S. Patent No. 5,312,940 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

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The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A metal carbene of the formula in claim 1 of the '940 patent where R, R¹, X, X¹, L, L¹ and M are commonly defined in the instant application as well as the patent. Note that the instant claims are a subgenus of claim 1 of the '940 patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Allowable Subject Matter

11. Claims 37 and 38 are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nazario-Gonzalez whose telephone number is (703) 308-4632. The examiner can normally be reached on Tuesday-Friday from 8:30 AM to 6:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

PNG

October 14, 1997


PORFIRIO NAZARIO-GONZALEZ
PRIMARY EXAMINER
GROUP 1200